

IN RESPONSE TO THE OFFICE ACTION:

REMARKS REGARDING AMENDMENTS

Independent claims 1, 37, and 73 have been amended to incorporate the limitations of dependent claims 14, 50, and 86 respectively, and dependent claims 14, 50, and 86 have been cancelled. Additionally, claims 15, 17-20, 51, 53-56, 87, and 89-92 have been amended to correct the dependency due to the cancellation of claims 14, 50, and 86. No new matter has been added by the amendments. Support for the amended claims is found in the original claims and specification.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-108 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Rudolph et al. ("Rudolph") in view of Slezak et al. ("Slezak"), in view of U.S. Patent No. 6,594,588 to Peden et al. ("Peden"), and in view of Mikami et al. ("Mikami"). Assignee respectfully requests that the Examiner reconsider and withdraw the above rejection of the claims in view of above amendments and the following remarks.

The fundamental basis for an obviousness determination under 35 U.S.C. §103(a) was set forth by the Supreme Court in *Graham v. John Deere Co.*, 383 US 1; 148 U.S.P.Q. 459 (1966). In subsequent cases involving a determination of obviousness under 35 U.S.C. §103, the Federal Circuit has noted that the following basic tenets of patent law must be adhered to: 1) the claimed invention must be considered as a whole; 2) the references must be considered as a whole and must suggest the desirability and, thus, the obviousness of making the combination; 3) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and 4) reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 U.S.P.Q. 182, 187, n.5 (Fed. Cir. 1986) (emphasis added). All of the claim limitations must be taught in order to establish obviousness. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Independent claim 1 as amended requires limitations not taught, disclosed, or suggested by Rudolph, Slezak, Peden, or Mikami. Claim 1 is directed to a method of collecting data about a plurality of samples that possess characteristics that change over time. Independent claim 1 as

amended requires storing a plurality of rules in a rule base; the rules determining whether a characteristic of a sample is to be collected based on past values of characteristics of the sample. Further, claim 1 requires the application of the rules to a plurality of past values (of the samples) that are also stored in the rule base to identify target samples to collect data from. The application of the rules to the past values (of the samples) also identify at least one target characteristic to be collected from the identified target samples.

Rudolph does not disclose, teach, or suggest any rule that determines whether a characteristic of a sample is to be collected based on past values of characteristics of the sample. Instead, Rudolph discloses rules such as assigning total fluorescence to digitonin killed cells, readings values at 0 time point and stopping reading at 24 hours. The identified claims of Rudolph simply determine when to begin and stop taking measurements and also provide a value to assign to a sample when a certain event has occurred. The identified rules of Rudolph do not determine whether a characteristic of a sample is to be collected based on past values of the sample. As such, the rules identified in Rudolph fail to teach all of the claim limitations of claim 1. The claim limitations of claim 1 are also not disclosed, taught, or suggested by Slezak, Peden, or Mikami. For at least these reasons, Assignee respectfully requests that the Examiner reconsider and withdraw the § 103(a) rejection of independent claim 1.

Claims 2–13 and 15–20 depend from independent claim 1 and thus, incorporate each limitation therein. Therefore, claims 2–13 and 15–20 are allowable for at least the same reason as independent claim 1. Assignee therefore respectfully requests that the Examiner also reconsider and withdraw the rejection of claims 2–13 and 15–20.

Independent claim 21 is directed to a method of scheduling data collection. Similar to amended claim 1, independent claim 21 requires storing a plurality of rules in a rule base; the rules determining whether a characteristic of a sample is to be collected based on past values of characteristics of the sample. Further, claim 21 requires the application of the rules to a plurality of past values that are also stored in the rule base to identify target samples to collect data from. The application of the rules to the past values also identify at least one target characteristic to be collected from the identified target samples. Claim 21 also requires the generation of user instructions to collect the data.

As discussed above, Rudolph discloses rules such as assigning total fluorescence to digitonin killed cells, readings values at 0 time point and stopping reading at 24 hours, but Rudolph fails to disclose, teach, or suggest a rule that determines whether a characteristic of a sample is to be collect based on past values of characteristics of the sample. Further, Rudolph does not disclose, teach, or suggest generating user instructions to collect data for at least one target characteristic to be collected from the samples. Slezak, Peden, and Mikami do not disclose, teach, or suggest these limitations. For at least these reasons, Assignee respectfully requests that the Examiner reconsider and withdraw the § 103(a) rejection of independent claim 21.

Claims 22–36 depend from independent claim 21 and thus, incorporate each limitation therein. Therefore, claims 22–36 are allowable for at least the same reason as independent claim 21. Assignee therefore respectfully requests that the Examiner also reconsider and withdraw the rejection of claims 22–36.

Independent claim 37 as amended requires limitations not taught, disclosed, or suggested by Rudolph, Slezak, Peden, and Mikami. Claim 37 is directed to a system for collecting data about a plurality of samples that possess characteristics that change over time. Like claim 1, claim 37 requires means for storing a plurality of rules in a rule base that determine whether a characteristic of a sample is to be collected that also identify the characteristic to be collected. Claim 37 also requires means for applying the plurality of rules to a plurality of past values to identify target samples to collect data from. As discussed above, Rudolph, Peden, Slezak, and Mikami fail to disclose, teach, or suggest these limitations. For at least these reasons, Assignee respectfully requests that the Examiner reconsider and withdraw the § 103(a) rejection of independent claim 37.

Claims 38–49 and 51–56 depend from independent claim 37 and thus, incorporate each limitation therein. Therefore, claims 38–49 and 51–56 are allowable for at least the same reason as independent claim 37. Assignee therefore respectfully requests that the Examiner also reconsider and withdraw the rejection of claims 38–49 and 51–56.

Independent claim 57 is directed to a system for scheduling data collection. Claim 57 requires means for storing a plurality of rules in a rule base; the rules determining whether a

characteristic of a sample is to be collected. Further, claim 57 requires means for applying the rules to a plurality of past values to identify target samples to collect data from. The means for applying the rules to the past values also identify at least one target characteristic to be collected from the identified target samples. Claim 57 also requires means for generating of user instructions to collect data. As discussed above, Rudolph, Slezak, Peden, or Mikami do not disclose, teach, and suggest these limitations. For at least these reasons, Assignee respectfully requests that the Examiner reconsider and withdraw the § 103(a) rejection of independent claim 57.

Claims 58–72 depend from independent claim 57 and thus, incorporate each limitation therein. Therefore, claims 58–72 are allowable for at least the same reason as independent claim 57. Assignee therefore respectfully requests that the Examiner also reconsider and withdraw the rejection of claims 58–72.

Independent claim 73 as amended requires limitations not taught, disclosed, or suggested by Rudolph, Slezak, Peden, and Mikami. Claim 73 is directed to a computer program product that collects data about a plurality of samples that possess characteristics that change over time. Like claims 1 and 37, amended claim 73 require a plurality of rules that determine whether a characteristic of a sample is to be collected and if so, that identify the characteristic to be collected based on past values of the samples. Claim 73 further requires applying the plurality of rules to a plurality of past values to identify at least one target characteristic to be collect from the identified samples. As discussed above, Rudolph, Peden, Slezak, and Mikami do not disclose, teach, or suggest these limitations. For at least these reasons, Assignee respectfully requests that the Examiner reconsider and withdraw the § 103(a) rejection of independent claim 73.

Claims 74–85 and 87–92 depend from independent claim 73 and thus, incorporate each limitation therein. Therefore, claims 74–85 and 87–92 are allowable for at least the same reason as independent claim 73. Assignee therefore respectfully requests that the Examiner also reconsider and withdraw the rejection of claims 74–85 and 87–92.

Independent claim 93 is directed to a computer program product that schedules data collection. Claim 93 requires a computer-readable program code that is configured to store a plurality of rules in a rule base; the rules determining whether a characteristic of a sample is to be

collected. Further, claim 93 requires computer-readable program code that is configured to apply the rules to a plurality of past values to identify target samples to collect data from. The computer-readable program code is also configured to apply the rules to the past values to identify at least one target characteristic to be collected from the identified target samples. The computer-readable program code of Claim 93 is also configured to generate user instructions to collect data. As discussed above, Rudolph, Slezak, Peden, and Mikami do not disclose, teach, or suggest these limitations. For at least these reasons, Assignee respectfully requests that the Examiner reconsider and withdraw the § 103(a) rejection of independent claim 93.

Claims 94–108 depend from independent claim 93 and thus, incorporate each limitation therein. Therefore, claims 94–108 are allowable for at least the same reason as independent claim 93. Assignee therefore respectfully requests that the Examiner also reconsider and withdraw the rejection of claims 94–108.

Assignee respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1–13, 15–49, 51–85, 87–108 and that the Examiner indicate the allowance of all pending claims in the next paper from the Office. The Examiner is invited to contact the undersigned attorney at 713.787.1697 with any questions, comments, or suggestions relating to the referenced patent application.

Respectfully submitted,



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